



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Preisig)	Art Unit: 2177
)	
Serial No.: 09/871,475)	Examiner: Le
)	
Filed: May 31, 2001)	SVL9-2001-0020-US1
)	
For: SYSTEM, METHOD, AND COMPUTER)	February 24, 2004
PROGRAM PRODUCT FOR REFORMATTING)	750 B STREET, Suite 3120
NON-XML DATA FOR USE WITH INTERNET)	San Diego, CA 92101
BASED SYSTEMS)	

RESPONSE TO OFFICE ACTION

Commissioner of Patents and Trademarks
Washington, DC 20231

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MAR 02 2004

Technology Center 2100

Dear Sir:

In response to the Office Action dated February 6, 2004, rejecting all pending claims as being anticipated by Davison, the enclosed Rule 132 declaration swears behind the earliest claimed priority date of Davison, removing it as a reference.

Insufficient evidence exists on the record that Davison is prior art to the present application, removing the rejection. Specifically, the filing date of Davison is after the present filing date. Davison claims priority to two earlier provisional applications but these provisional applications have not been made of record nor has the examiner made a sworn statement (meaning under penalty of perjury) to the effect that she has reviewed the provisional applications and that the relied-upon subject matter of Davison is supported by them. Consequently, there is no way to ascertain on the basis of the present record whether the relied-upon provisional applications support the subject matter in Davison being relied on to reject the claims. In fact

they very well may not, given the realities of provisional practice. Accordingly, on the basis of the current record Davison has not been shown to be prior art to the present claims.

Moreover, contrary to the rejections Davison does not teach, e.g., the parameterized database system query language statement residing in the middleware file of, e.g., Claim 1. First, claims must be construed as one skilled in the art would so construe them in light of the specification, MPEP §2111.01. With this in mind, as one skilled in the art would understand it the enabler agent 102 of Davison, relied on as the claimed "middleware", is actually part of the server 110, see Figure 1 of Davison. Second, even if the enabler agent were construed to be "middleware", it does not include a parameterized SQL query statement. The relied-upon paragraphs of Davison (0014, 0047, 0056) teach only that the enabler agent 102 *maps* data (paragraphs 0014 and 0047) (emphasis mine) as opposed to querying; and that data in the database 112 may be stored in SQL *format* (paragraph 0056) (emphasis mine) as opposed to the data containing a parameterized SQL query statement. In fact, it does not appear that Davison, even when read in its broadest sense, teaches, among other things, using a middleware file that has an embedded parameterized query statement in it. Indeed, the client in Davison appears to generate the query (paragraphs 0059 and 0060) and the enabler agent 102 accesses pre-generated database queries that are stored *on the server 110* (emphasis mine), not on the enabler agent 102 that has been relied on as the claimed "middleware" (paragraphs 0061 and 0066 of Davison). For this further reason, the claims are patentable.

The examiner has attempted to meet the above arguments by arguing that the enabler agent 102 "equals" middleware, and by also arguing that just because the enabler agent "works in tandem" with the server database, then that means that the enabler "inherently" contains an SQL file.

The enabler agent is not "middleware", and the examiner cannot make it such by waving a magic wand over it. The enabler agent 102 is shown in Figure 1 as being part of the XML server 110, the same element that contains the database and evidently the element being used in the role of the "server" in Claim 1. The examiner is encouraged to familiarize herself with MPEP §2111.01 (claims must be interpreted as those skilled in the art would interpret them). By failing to show that those skilled in the art regard parts of servers to be middleware *apart* from those servers, the examiner dooms her case.

The examiner is encouraged to familiarize herself with MPEP §2112 (an allegedly inherent characteristic must *necessarily* be part of a relied-on element). The examiner cannot show this to be the case by resorting to that old standby, the magic wand, and proclaiming that the enabler agent of Davison "must" contain an SQL statement. The relied-upon section of Davison simply says that the enabler "works in tandem" with the server database. It doesn't say how. There are many ways it could work in tandem as disclosed, not simply in the untaught way deemed necessary by the examiner. One wonders, if the enabler agent "must" use SQL, why didn't Davison disclose it to comply with 35 U.S.C. §112, first paragraph? An inadequate enabling disclosure under the first paragraph of Section 112 of the patent laws renders a reference defective as an anticipatory reference, Akzo N.V. v. U.S. I.T.C., 808 F.2d 1471 (Fed. Cir. 1986). Either Davison's enabler agent does not "inherently" use an SQL statement, dooming the examiner's case, or it uses it and Davison failed to mention this fact, arguably dooming Davison as a reference as used by the examiner.

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Submitted,



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